APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,916	10/05/2000	Robert E. Ellingson	13481.1US01	8813

23552	7590	11/09/2005

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER
MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	09/679,916	ELLINGSON, ROBERT E.
Office Action Summary	Examiner	Art Unit	
	Aravind K. Moorthy	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 October 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>05 October 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. This is in response to the amendment filed on 24 October 2005.

2. Claims 1-26 are pending in the application.

3. Claims 1-26 have been rejected.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37

CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible

for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR

1.114. Applicant's submission filed on 24 October 2005 has been entered.

Response to Arguments

5. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view

of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-4, 11-21 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by**

Labaton U.S. Patent No. 6,957,185 B1.

As to claim 1, Labaton discloses a method of verifying the identity of a registered user, the method comprising:

(a) obtaining a list of at least two identity verifiers, each identity verifier to be used for no more than one transaction [column 13 line 62 to column 15 line 60];

(b) linking the list of identity verifiers to at least one unique numerical identifier wherein the unique numerical identifier is associated with the registered user, the registered user selected from a group consisting of persons and entities [column 13 line 62 to column 15 line 60];

(c) providing the list of identity verifiers to the registered user [column 13 line 62 to column 15 line 60];

(d) receiving a numerical identifier from a requesting party, the requesting party having obtained the numerical identifier from a transaction initiator claiming to be associated with the numerical identifier [column 13 line 62 to column 15 line 60];

(e) receiving an identity verifier from the requesting party, the requesting party having obtained the numerical identifier from a transaction initiator claiming to be associated with the numerical identifier [column 13 line 62 to column 15 line 60];

(f) determining whether the received identity verifier is within the list of identity verifiers linked to the received numerical identifier [column 13 line 62 to column 15 line 60]; and

(g) communicating information to the requesting party indicating whether the received identity verifier is within the list of identity verifiers linked to the received numerical identifier [column 13 line 62 to column 15 line 60].

As to claim 2, Labaton discloses that the communicating information step signals that the received identity verifier has not been used before and is within the list of identity verifiers linked to the received numerical identifier by sending a verification transaction identifier to the requesting party [column 13 line 62 to column 15 line 60].

As to claim 3, Labaton discloses the method further comprising:

(a) determining whether the identity verifier received from the requesting party has been used before [column 13 line 62 to column 15 line 60]; and

(b) communicating information to the requesting party signaling whether the identity verifier has been used before [column 13 line 62 to column 15 line 60].

As to claim 4, Labaton suggests archiving the identity verifier and the verification transaction identifier [column 13, lines 33-61].

As to claim 11, Labaton discloses receiving a uniqueness suffix and wherein determining whether the received identity verifier is within the list of identity verifiers linked to the received numerical identifier further comprises determining whether the received identity verifier is within the list of identity verifiers linked to the received numerical identifier and the received uniqueness suffix [column 13, lines 12-32].

As to claim 12, Labaton discloses receiving a numerical identifier. Labaton discloses receiving an identity verifier and communicating information to the requesting party are performed by voice communications over a phone line [column 12 line 56 to column 13 line 11].

As to claim 13, Labaton discloses that receiving a numerical identifier, receiving an identity verifier and communicating information to the requesting party are performed through electronic communication through a wide area network [column 4, lines 20-34].

As to claim 14, Labaton discloses a method of determining whether an identity verifier is required to be submitted in a particular transaction, the method comprising the steps of:

(a) obtaining a list of at least two identity verifiers, each identity verifier to be used for no more than one transaction [column 13 line 62 to column 15 line 60];

(b) linking the list of identity verifiers to at least one unique numerical identifier wherein the numerical identifier is associated with a registered user selected from a group consisting of persons and entities [column 13 line 62 to column 15 line 60];

(c) creating categories of transactions [column 13 line 62 to column 15 line 60];

(d) receiving instructions from the registered user designating the categories of transactions that require an identity verifier and designating the categories of transactions that do not require an identity verifier [column 13 line 62 to column 15 line 60];

(e) receiving a numerical identifier from a requesting party, the requesting party having obtained the numerical identifier from a transaction initiator claiming to be associated with the numerical identifier [column 13 line 62 to column 15 line 60];

(f) receiving information from the requesting party specifying the type of transaction occurring [column 13 line 62 to column 15 line 60];

(g) determining whether the transaction requires the use of an identity verifier [column 13 line 62 to column 15 line 60]; and

(h) communicating information to the requesting party wherein the information communicated indicates whether an identity verifier is required for the specified transaction [column 13 line 62 to column 15 line 60].

As to claim 15, Labaton discloses an identity verification system for verifying the identity of a registered user, the system comprising:

(a) a database for storing information pertaining to the registered user selected from a group consisting of persons and entities, wherein the database is configured to receive at least one unique numerical identifier associated with the registered user and at least two identification verifiers associated with the registered user, each identification verifier to be used for no more than one transaction [column 13 line 62 to column 15 line 60];

(b) an input module for inputting at least one numerical identifier associated with the registered user and at least two identification verifiers associated with the registered user into the database so that the at least one

numerical identifier is linked to the at least two identification verifiers [column 13 line 62 to column 15 line 60];

(c) a communications module for two way communications for receiving a numerical identifier and an identification verifier from a requesting party, the requesting party having obtained the numerical identifier and the identification verifier from a transaction initiator claiming to be associated with the numerical identifier, and for communicating a message to the requesting party relating to whether the received identification verifier is one of the identification verifiers linked to the received numerical identifier and if the identification verifier has been used before [column 13 line 62 to column 15 line 60];

(d) a processor module for comparing the numerical identifier and identification verifier received by the communications module with the information in the database to determine whether the received identification verifier is one of the identification verifiers linked to the received numerical identifier and if the identification verifier has been used before [column 13 line 62 to column 15 line 60].

As to claim 16, Labaton discloses that the database and the processor module are contained within a single computer [column 4, lines 9-19].

As to claim 17, Labaton discloses that the input module is a keyboard [column 4, lines 9-195]

As to claim 18, Labaton discloses that the communications module is a serial port and a modem [column 4, lines 20-34].

As to claim 19, Labaton discloses that the communications module is a network adapter [column 4, lines 20-34].

As to claim 20, Labaton discloses a remote terminal for communicating with an identity verification system, the remote terminal comprising:

(a) an input module for inputting a numerical identifier and an identification verifier [column 13 line 62 to column 15 line 60];

(b) a communications module for sending the numerical identifier input with the input module and the identification verifier input with the input module to a remotely located system storing a plurality of numerical identifiers and at least two identity verifiers linked with each numerical identifier, and for receiving a message from the remotely located system indicating whether the numerical identifier input with the input module is linked to the identification verifier input with the input module, and whether the identification verifier has been used before, the communications module also configured to receive from the remotely located system a verification transaction identifier and a security message linked with the identification verifier, the security message provided by the registered user [column 13 line 62 to column 15 line 60]; and

(c) an output module for reporting the messages received by the communications module from the remote system; wherein each numerical identifier stored by the remotely located system is associated with a registered user selected from a group consisting of persons and entities [column 13 line 62 to column 15 line 60].

As to claim 21, Labaton discloses that the input module comprises a keypad [column 12, lines 40-55].

As to claim 23, Labaton discloses that the output module comprises a display screen [column 4, lines 9-19].

As to claim 24, Labaton discloses that the output module comprises a monitor [column 4, lines 9-19].

As to claim 25, Labaton discloses a computer program storage medium readable by a computing system and encoding a computer program of instructions for executing a computer process for verifying the identity of a registered user, the computer process comprising:

(a) storing at least two identity verifiers in a database, each identity verifier to be used for no more than one transaction, as discussed above;

(b) storing at least one unique numerical identifier associated with the registered user in a database, wherein the at least two identity verifiers are linked to the at least one numerical identifier, the registered user selected from a group consisting of persons and entities, as discussed above;

(c) receiving a numerical identifier, as discussed above;

(d) receiving an identity verifier, as discussed above;

(e) comparing the received numerical identifier and received identity verifier to the stored numerical identifier and stored identity verifiers to determine whether the received identity verifier is one of the identity verifiers linked to the received numerical identifier, as discussed above; and

(f) communicating information to the requesting party indicating whether the received identity verifier is one of the identity verifiers linked to the received numerical identifier, and whether the identity verifier has been used before, as discussed above in rejection of claim 1.

As to claim 26, Labaton discloses a method of verifying the identity of a registered user, the method comprising:

(a) obtaining a list of at least two identity verifiers, each identity verifier to be used for no more than one transaction, as discussed above;

(b) linking the list of identity verifiers to at least one unique numerical identifier wherein the unique numerical identifier is associated with the registered user, as discussed above;

(c) providing the list of identity verifiers to the registered user [column 13 line 62 to column 15 line 60];

(d) receiving a numerical identifier from a requesting party, the requesting party having obtained the numerical identifier from a transaction initiator claiming to be associated with the numerical identifier, as discussed above;

(e) receiving an identity verifier from a requesting party, the requesting party having obtained the numerical identifier from a transaction initiator claiming to be associated with the numerical identifier, as discussed above;

(f) determining whether the received identity verifier is within the list of identity verifiers linked to the received numerical identifier, as discussed above;

(g) communicating information to the requesting party indicating whether the received identity verifier is within the list of identity verifiers linked to the received numerical identifier, as discussed above;

(h) determining whether the identity verifier received from the requesting party has been used before, as discussed above; and

(i) communicating information to the requesting party signaling whether the identity verifier has been used before, as discussed above in rejection of claims 1 and 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Labaton U.S. Patent No. 6,957,185 B1 as applied to claim 1 above, and further in view of Kuhns et al U.S. Patent No. 6,047,281.**

As to claim 5, Labaton does not teach storing public information about the registered user whose identity is to be verified. Labaton does not teach creating at least two categories of requesting parties. Labaton does not teach receiving instructions from the registered user regarding what public information is allowed to be released to each of the at least two categories of requesting party. Labaton does not teach determining the category of the requesting party.

Labaton does not teach communicating the appropriate public information to the requesting party pursuant to the instructions from the registered user.

Kuhns et al teaches storing public information about the registered user whose identity is to be verified [column 1, lines 22-38]. Kuhns et al teaches creating at least two categories of requesting parties. Kuhns et al teaches receiving instructions from the registered user regarding what public information is allowed to be released to each of the at least two categories of requesting party. Kuhns et al teaches determining the category of the requesting party [column 16, lines 1-46]. Kuhns et al teaches communicating the appropriate public information to the requesting party pursuant to the instructions from the registered user [column 17, lines 24-48].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Labaton so that there would have been public information stored about the registered user whose identity is to be verified. There would have been at least two categories created of requesting parties. The registered user would have sent messages regarding what public information is allowed to be released to each of the at least two categories of requesting party. The category of the requesting party would have been determined. The appropriate public information would have been sent to the requesting party pursuant to the instructions from the registered user.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Labaton by the teaching of Kuhns et al because it helps eliminate fraud and protects the general public from individuals with criminal records [column 2, lines 30-50].

8. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Labaton U.S. Patent No. 6,957,185 B1 as applied to claim 1 above, and further in view of Shkedy U.S. Patent No. 6,236,972.

As to claims 6 and 9, Labaton does not teach that the at least one numerical identifier is a social security number or a phone number.

Shkedy teaches an identifier being a social security number or a phone number [column 13, lines 16-29].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Labaton so that the pseudorandom number would have been replaced by the social security number or the phone number of the user.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Labaton by the teaching of Shkedy because both of those numbers are unique and easily remembered [column 13, lines 16-29].

9. Claims 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Labaton U.S. Patent No. 6,957,185 B1 as applied to claim 1 above, and further in view of Gonzalo U.S. Patent No. 6,796,494 B1.

As to claims 7, 8 and 10, Labaton does not teach that the at least one numerical identifier is a drivers license number, bank account number or a credit card number.

Gonzalo teaches an identifier that can be a drivers license number, bank account number or a credit card number [column 6 line 51 to column 7 line 4].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Labaton so that the numerical identifier would have been one of a drivers license number, bank account number or a credit card number.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Labaton by the teaching of Gonzalo because the information on these cards have already been set up and established and does not require a user to set up numerical identifiers with the provider [column 6 line 51 to column 7 line 4].

10.   Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Labaton U.S. Patent No. 6,957,185 B1 as applied to claim 20 above, and further in view of Henn U.S. Patent No. 5,770,844.

As to claim 22, Labaton does not teach that the input module comprises a keypad and a magnetic card reader wherein the magnetic card reader receives the numerical identifier and the keypad receives the identification verifier.

Henn teaches an input module that comprises a keypad and a magnetic card reader wherein the magnetic card reader receives the numerical identifier and the keypad receives the identification verifier [column 2, lines 51-62].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Labaton so that the input module would have comprised a keypad for the identification verifier and a magnetic card reader for the numerical identifier.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Labaton by the teaching of Henn because it provides the user with a portable form of authentication [column 2, lines 51-62].

Conclusion

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy AM
November 4, 2005

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100